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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/869,643      | 07/02/2001  | Hideo Kobayashi      | 0445-0306P          | 5831             |

2292 7590 09/16/2003

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

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| EXAMINER |
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PARKER, FREDERICK JOHN

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| ART UNIT | PAPER NUMBER |
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1762

DATE MAILED: 09/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/869,643

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE — 3 — MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 7/21/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-5 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-5 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some\* ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☒ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Objections***

2. Claims 1-5 are objected to because of the following informalities:
  - Claims 1-5; on line 1-second word of each claim, "intermittently" before "laying" should be "intermittent" for grammatical correctness.
  - Claims 3-5, first word of first line, "An" should be "The" because the claim is a dependant claim.
  - Claim 1, line 2, "thereon" in context is grammatically incorrect in context; line 7, a common should be inserted after "member"; line 9, a comma should be inserted after "laid".
  - Claim 2, lines 5,8,9 "on an" and "side" on either side of "upstream" and "downstream" should be deleted for clarity.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method and apparatus for applying intermittent or discontinuous layers/ coatings (= "laying") to a sheet, does not reasonably provide enablement for applying continuous coatings. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to carry out the invention commensurate in scope with these claims. The disclosure *expressly* teaches applying a film/ coating to a sheet in an intermittent or discontinuous manner, the sheet product having coated 14 and non-coated 15 portions as clearly illustrated in figure 1 (left end), page 10, 15-29, page 11, 7-15; etc. This is also a CRITICAL ASPECT of the invention, on which potential allowance is based (see subsequent section).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-3,5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 is vague and indefinite because: on lines 4-6, it is unclear if the sheet member must be moving or stationary; line 2, the meaning of "in the moving direction" is confusing and superfluous in context; line 5, it is unclear what is meant by a "surface side" since the terms are synonymous; line 6 is vague and indefinite because it is unclear which site (upper or lower) of the laying means is intended; line 7, the step is vague and indefinite because according to the specification and figure 1 a discontinuous surface is

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formed which is coated to create an intermittent coating comprising coated 14 and non-coated 15 portions on the substrate, and further it is unclear how is formed the “surface-to-be-laid on a surface side”; line 9 is vague and indefinite because it is unclear how anything but an intermittent/ discontinuous coating is applied; line 9, “laid layer” (singular) lacks antecedent basis; line 10, the phrase “bringing back” in context is unclear and confusing; line 11 is vague and indefinite because it is unclear how the non-coated sheet is made flush with the “surface-to-be-laid” when the layer has already been applied in a previous step; lines 12-13 are vague and indefinite because (1) the meaning is unclear, and (2) it is unclear if it is an additional step, part of a previous step, or merely a part of a product description.

- Claim 2 is vague and indefinite because: it is unclear if the sheet member of lines 2,46,8 must be moving or stationary; line 3, the meaning of “in the moving direction” is confusing and superfluous in context; lines 7-8, the step is vague and indefinite because according to the specification and figure 1 a discontinuous surface is formed which is coated to create an intermittent coating on the substrate comprising coated 14 and non-coated 15 portions, and further it is unclear how is formed the “surface-to-be-laid on a surface side”; line 9, the phrase “bringing back” in context is unclear and confusing; last 2 lines are vague and indefinite because it is unclear how the non-coated sheet is made flush with the “surface-to-be-laid” when the layer has already been applied in the previous step.
- Claim 3; line 2 is vague and indefinite because it is unstated how the means is “adapted” to form a cut line; lines 3-4 are vague and indefinite because it is unclear if the cut line

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extends ONLY into the laid layer or the sheet-like member with coating thereon; line 3 is vague and indefinite because according to the specification the coating applied to the substrate is intermittent/ discontinuous.

- Claim 5 is vague and indefinite because it is unclear what is meant by "function" for adjusting widths since it provides no structure to further limit the apparatus, structure being required to determine patentability of an apparatus in accordance with MPEP 2114.

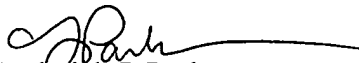
The prior art does not teach nor suggest forming intermittent/ discontinuous coatings/ layings on a moving sheet-like substrate according to the method and apparatus of the claims, and in view of figure 1 and accompanying text. The closest prior art in this regard is: US 2598264 and 3769058 which teaches using a printing roller to apply discontinuous coatings on sheet-like substrates; US 5217722 discloses a grooved conveyor belt; EP 1 229 106 uses an extrusion coater to apply a doughy detergent; JP 2003-71347 intermittently coats a belt and shutter means. It is the Examiner's opinion that the Stated Prior Art does not teach, nor fairly suggest to combine, the cited references to produce the invention in this Application. Allowance of claims is predicated on Applicants overcoming the 35 USC 112 issues above to clearly and distinctly claim the intended invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 703/308-3474. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703/308-2333. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/308-0661.

  
Frederick J. Parker  
Primary Examiner  
Art Unit 1762

fjp